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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,739	11/13/2003	Indran Naick	AUS920030777US1(4016)	2701
45557 7590 05/22/2009 IBM CORPORATION (JSS) C/O SCHUBERT OSTERRIEDER & NICKELSON PLLC 6013 CANNON MOUNTAIN DRIVE, S14 AUSTIN, TX 78749				
EXAMINER				
BIAGINI CHRISTOPHER D				
ART UNIT		PAPER NUMBER		
2442				
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05/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,739

Applicant(s)

NAICK ET AL.

Examiner

Christopher Biagini

Art Unit

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8-10,12,13,15-18,20,23 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,8-10,12,13,15-18,20,23 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to the objection to the specification and the rejections under 35 USC 112, first paragraph have been fully considered but are not persuasive. Applicant provides several paragraphs from the specification in an attempt to show the features in question, but neither addresses the Examiner's reasoning nor explains how those paragraphs show the features. As explained in the objection and rejections, claims 1, 10, 18, and 33-35 require specific steps to occur "by the email server." However, these steps are only described in conjunction with the user. There is no explanation, for example, of how the user interacts with the server to compose messages in the specific order required, or how the server autonomously generates the messages in the order. Thus, the objection to the specification and the rejections under 35 USC 112, first paragraph are maintained.

Applicant's arguments with respect to the rejections of claims 1, 3, 4, 9, 10, 12, 15, 17, 18, 20, and 33-35 under 35 USC 103(a) have been fully considered but are not persuasive.

Applicant first addresses Mansour individually in connection with claims 1, 10, and 18. However, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Mansour is not relied upon to teach the entire "identifying" and

“generating” steps; rather, Mansour is relied upon to show, among other things, performing steps at a server based on input from a client.

Next, Applicant addresses Gilbert in connection with claims 3, 12, 18, and 20. The Examiner first notes that Applicant appears to have inadvertently quoted col. 4, lines 16-21 of Beyda, which is directed toward a user interacting with icons or other prompts. The examiner agrees that this is not the same thing as recited in claim 3; however, the cited section of *Gilbert* discusses recognizing processing codes (marks) embedded in email messages, which are indicative of bounding edges of instances. Applicant also quotes col. 8, lines 1-16 of Gilbert, but merely asserts that “the connotation differs from Applicant’s claim 3.” As Applicant has not explained how the language of the claims distinguishes over the cited references, this argument cannot be considered persuasive.

Applicant’s arguments with respect to claim 4, 9, 15, 17, 33, 34, and 35 cannot be considered persuasive, as Applicant has not explained how the language of the claims distinguishes over the cited references.

Applicant’s arguments attacking Mansour individually in connection with claims 33, 34, and 35 are not persuasive, as one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Applicant’s arguments attacking Rafal individually in connection with claims 18, 16, and 23 are not persuasive, as one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Applicant's arguments attacking Altavilla individually in connection with claim 13 is not persuasive, as one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification must provide antecedent basis for generating, by the server, emails in an order of generation based upon the groups of recipients, as claimed in claims 1, 10, and 18, and further limited in claims 33-35.

Claim Rejections - 35 USC § 112

Claims 1, 3, 4, 8-10, 12, 13, 15-18, 20, 23 and 33-35 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 10, and 18 recite the limitation “generating, by the email server, an email...wherein generating the email and the one or more additional email comprises generating the email...in an order of generation based upon the groups of recipients.”

Paragraph [35] of the specification discusses ordering, but only in conjunction with the user. The claims require that the server performs the ordering, but there is no explanation in the specification of how the user interacts with the server to compose messages in order.

Claims 33-35 further recite: “wherein generating the email and the one or more additional emails comprises generating the email comprising the email message with the instance and the one or more additional emails in the order, wherein the order comprises composing a general message for all recipients, thereafter composing a detailed message for a group of the recipients, and thereafter composing specific messages for individual recipients that are part of the group of the recipients.”

Again, these features are only discussed with respect to user interactions. The claims require that the server performs the ordering, but there is no explanation for how the server and the user interact to compose the messages in order.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 9, 10, 12, 15, 17, 18, 20, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US Patent No. 6,636,965) in view of Gilbert (6,529,942), and further in view of Mansour (US Pub. No. 2002/0111995).

Regarding claim 1, Beyda shows a method for employing private content (recipient-specific comments: see col. 3, lines 3-7) in an email message for recipients, the method comprising:

- receiving, at an email server (message processor 20), the email message addressed to the recipients from an email client (see col. 2, lines 40-51 and col. 3, lines 28-32);
- identifying, by the email server, in response to receipt of the email message from the email client, an instance of the private content in the email message (see col. 3, lines 33-37);
- determining, by the email server, an association between the instance and at least one recipient (step 72: see col. 3, lines 46-53), wherein the email server does not determine associations between the instance and one or more remaining recipients of the recipients (note that Beyda provides for at least one recipient not being associated with the instance: see col. 3, lines 53-55);
- generating, by the email server, an email for the recipient based upon determining the association, the email comprising the email message with the instance (steps 76 and 78: see col. 3, lines 55-59);
- generating, by the email server, one or more additional emails for the one or more remaining recipients, wherein generating the one or more emails comprises redacting the email message to exclude the instance (step 74, comprising transmitting only the common portion: see col. 3, lines 53-55), wherein a redacted

email message is created (comprising an email without comments), and generating the one or more additional emails with the redacted email message to display the email message with the instance when routed to the recipient (note that the message would display the instance since it is included in the message: see step 78) and to exclude the instance when routed to the one or more remaining recipients (see step 74); and

- transmitting, by the email server, the emails to the recipients (steps 74 and 78: see col. 3, lines 53-59).

Beyda further shows:

- identifying groups of recipients to receive the same or substantially similar email messages (comprising a group which receives a common message, and a group which receives a common message and comments: see col. 3, lines 8-18); and
- generating the email comprising the email message with the instance and the one or more additional emails in an order of generation based upon the groups of recipients (comprising first generating a common message which is sent to the group of all recipients and then generating comments for a group comprising a subset of all recipients: see col. 3, lines 8-18).

Beyda does not explicitly show:

- that the identifying and generating steps are performed at the server; and
- that associations are determined in response to identifying instances.

Mansour shows performing steps at a server based on input from a client (comprising application functionality: see [0008]). It would have been obvious to one of ordinary skill in the

art at the time of the invention to modify the system of Beyda with the performing of steps at a server as taught by Mansour in order to allow a user to interact with the system using an inexpensive, low-end device (see Mansour, [0008]).

Gilbert shows an email server determining associations between instances of content and recipients in response to identifying the instances (see col. 8, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Beyda with the responsive determination of Gilbert in order to avoid wasting time determining associations when there are no instances of a particular kind of content in an email message.

Regarding claim 3, the combination further shows wherein identifying the instances comprises identifying a mark adjacent to the instance, wherein the mark is indicative of a bounding edge of the instance (see Gilbert, col. 4, lines 16-21 and col. 8, lines 1-16).

Regarding claim 4, the combination further shows wherein identifying the instance comprises identifying the instance as a highlighted portion of text in response to a command from a user (see Gilbert, col. 6, lines 38-47).

Regarding claim 9, the combination further shows wherein redacting the email message to exclude the instance comprises deleting the instance from the email message (note that before redacting, the comments are in the message of Beyda, and after redacting, the message contains only the common content: see col. 3, lines 3-7 and 53-55).

Regarding claim 10, Beyda shows an apparatus (mail processor 20) for employing private content in an email message for recipients, the apparatus being part of an email server (see col. 2, lines 40-51) and comprising a computer processor and memory (implicitly provided by the disclosure of an email server), the memory comprising computer instructions comprising:

- a content identifier to receive the email message from an email client (see col. 2, lines 40-51 and col. 3, lines 28-32) and, in response, to identify one or more instances of private content in the email message (see col. 3, lines 33-37);
- a content associator to determine an association between at least one instance and a first set of one or more of the recipients (step 72: see col. 3, lines 46-53);
- an email generator to generate a first email for each recipient in the first set comprising at least one instance based upon an association with the at least one instance (steps 76 and 78: see col. 3, lines 55-59) and to redact the at least one instance from the email message to generate emails for additional sets of recipients (step 74, comprising transmitting only the common portion: see col. 3, lines 53-55), if any, to display the email message with the at least one instance when routed to the first set of one or more recipients (note that the message would display the instance since it is included in the message: see step 78) and to exclude the at least one instance when routed to other recipients (see step 74); and
- a messaging gateway coupled with the email generator to transmit the emails to the recipients (steps 74 and 78: see col. 3, lines 53-59).

Beyda further shows:

- a recipient selector to identify groups of recipients to receive the same or substantially similar email messages (comprising a group which receives a common message, and a group which receives a common message and comments: see col. 3, lines 8-18); and
- the email generator to generate emails in an order of generation based upon the groups of recipients (comprising first generating a common message which is sent to the group of all recipients and then generating comments for a group comprising a subset of all recipients: see col. 3, lines 8-18).

Beyda does not explicitly show:

- that the identifying and generating steps are performed at the server; and
- associating remaining instances, if any, with additional sets of recipients.

Mansour shows performing steps at a server based on input from a client (comprising application functionality: see [0008]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Beyda with the performing of steps at a server as taught by Mansour in order to allow a user to interact with the system using an inexpensive, low-end device (see Mansour, [0008]).

Gilbert shows associating multiple instances of content in an email with multiple sets of recipients (see Fig. 5 and col. 8, lines 8-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Beyda with the multiple instances and additional sets of recipients taught by Gilbert in order to provide increased flexibility when composing messages to diverse groups.

Claim 12 corresponds to claim 3 and is rejected for the same reasons as given above.

Regarding claim 15, the combination further shows wherein the content associator is configured to generate an index associating the first set of the recipients with at least one location of one or more instances in the email message (see Gilbert, col. 5, lines 6-25).

Claim 17 corresponds to claim 9 and is rejected for the same reasons as given above.

Claims 18 and 20 correspond to claims 1 and 3 and are rejected for the same reasons as given above.

Regarding claim 33, the combination further shows wherein generating the email and the one or more additional emails comprises generating the email comprising the email message with the instance and the one or more additional emails in the order, wherein the order comprises composing a general message for all recipients (comprising a common message: see Beyda, col. 3, lines 8-10), thereafter composing a detailed message for a group of the recipients (comprising the common message plus comments, which is sent to a group comprising a subset of all recipients: see Beyda, col. 3, lines 14-18), and thereafter composing specific messages for individual recipients that are part of the group of the recipients (see Beyda, col. 3, line 44 to col. 4, line 2, especially col. 4, line 66 to col. 4, line 2).

The combination does not explicitly show wherein all the steps are performed at the server.

Mansour shows performing steps at a server based on input from a client (comprising application functionality: see [0008]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Beyda with the performing of steps at a server as taught by Mansour in order to allow a user to interact with the system using an inexpensive, low-end device (see Mansour, [0008]).

Claims 34 and 35 correspond to claim 33 and are rejected for the same reasons as given above.

Claims 8, 16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US Patent No. 6,636,965) in view of Gilbert (6,529,942), and further in view of Mansour (US Pub. No. 2002/0111995) and Rafal (US Pub. No. 2002/0002586).

Regarding claim 8, the combination shows the limitations of claim 1 as applied above, and further shows displaying the message without the instance in response to routing the email to the one or more remaining recipients (necessarily the case, as the message is displayed in response to routing the email and the instance is not included in the email: see Beyda, col. 1, lines 59-67).

The combination does not show using hypertext markup language code to display the email message.

Rafal shows using hypertext markup language code to display email content (see [0037]). It would have been obvious to one of ordinary skill in the art at the time of the invention to

further modify the system of Beyda with the HTML code taught by Rafal in order to provide for text formatting in the email.

Regarding claims 16 and 23, the combination shows the limitations of claims 10 and 18 as applied above, and further shows displaying the instance in response to routing the email to the recipient (necessarily the case, as the message is displayed in response to routing the email and the instance is included in the email: see Beyda, col. 1, lines 59-67).

The combination does not show using hypertext markup language code to display the instance.

Rafal shows using hypertext markup language code to display email content (see [0037]). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system of Beyda with the HTML code taught by Rafal in order to provide for text formatting in the email.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US Patent No. 6,636,965) in view of Gilbert (6,529,942), and further in view of Mansour (US Pub. No. 2002/0111995) and Altavilla (US Pub. No. 2002/0194280).

The combination shows the limitations of claim 10 as applied above, but does not show wherein the content identifier is configured to parse a table, wherein the table identifies a location of the instance in the email message.

Altavilla shows parsing a table, wherein the table identifies a location of an instance of content in an email message (the table comprising a set of tags attached to recipients: see Fig. 3 and [0025]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system of Beyda to use a table as taught by Altavilla in order to associate recipients with appropriate instances of content without inserting markup into the email body.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Biagini whose telephone number is (571) 272-9743. The examiner can normally be reached on weekdays from 8:30 AM to 5:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2442

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